

## **Remarks**

### **I. Status of the Application and Claims**

As originally filed, the present application had a total of 6 claims. Due to various additions and deletions during prosecution, the claims pending at the time that the present Office Action was issued were 16-19. Claims 18 and 19 have been canceled herein and new claim 20 has been added. Thus, the claims pending after the entry of the present amendment will be 16, 17 and 20.

### **II. The Amendments**

New claim 20 has been added herein. This specifies a narrower range for the DBP/CTAB ratio of claim 16. Specifically, the lower limit in the range has been raised to 1.545. Support for this ratio may be found in Example 3 on page 13 of the specification, line 16. Support for the upper limit, *i.e.*, 3.5, may be found in original claim 16 as well as in Example 1 of the specification. The present Amendment does not add new matter to the application and its entry is therefore respectfully requested.

### **III. Submission of Declaration by Dr. Görl**

In support of the patentability of the present claims, Applicants are submitting herewith a Declaration Under 37 C.F.R. § 1.132 by Dr. Udo Görl, one of the inventors named on the above-captioned application.

## **The Rejections**

### **I. Rejection of Claims Under 37 C.F.R. § 1.75(c)**

On page 2 of the Office Action, the Examiner rejects claims 18 and 19 as being of improper dependent form. In response, Applicants have canceled claims 18 and 19 without prejudice, thereby obviating the Examiner's rejection.

### **II. Rejection of Claims Under 35 U.S.C. § 102 or 103**

On pages 2-3 of the Office Action, the Examiner repeats the same rejections that have been made several times during prosecution. Specifically, all claims are rejected as being

anticipated by, or obvious over, Lagarde, *et al.* (U.S. 4,704,425) or Lagarde and Johnson, *et al.* (U.S. 4,681,750). The rejections are based upon four main arguments. These are as follows:

1. Declarations previously submitted by Applicants are not relevant to patentability because they compare vulcanized rubber products made using silicas rather than silicas *per se*.
2. Although Lagarde only discloses a few of the silica properties recited in Applicants' claims, the remaining properties are inherent in the ones disclosed.
3. Johnson does not expressly disclose silicas having the properties recited in Applicants' claims, but the silicas described therein are made by essentially the same process disclosed by Applicants. Therefore, the silicas must be the same.
4. In the case of particle size, Lagarde indicates that disclosed particles are less than 45 microns. Because this subsumes all smaller particles, claims relying upon particle smaller size for novelty are anticipated.

Throughout prosecution, the Examiner has offered little explanation for any of the above allegations. For example, no attempt is made to show that the undisclosed parameters in Lagarde are the necessary consequence of the parameters disclosed or to explain how this reference enables the production of all silica particles less than 45 microns.<sup>1</sup> It is Applicants' position that each of the allegations above is incorrect, and unsupported. As evidence of this, Applicants are submitting herewith a Declaration by an expert in the field of rubber technology who is also one of the inventors. This addresses each allegation and explains the relevance of previous Declarations that have been submitted by Applicants but that the Examiner has chosen to ignore. In the sections below, Applicants point out the portions of the enclosed Declaration that are important to each allegation.

**A. Relevance of Previously Submitted Declarations**

It should be appreciated that the properties of an end product can be used to support the patentability of an intermediate used in its production when the properties observed can reasonably be attributed to the intermediate. For example, section 716.02(b) of the MPEP states:

The patentability of an intermediate may be established by unexpected properties of an end product “when one of ordinary skill in the art would reasonably ascribe to a claimed intermediate the ‘contributing cause’ for such an unexpectedly superior activity or property.”

In paragraph 7 of the enclosed Declaration, Dr. Görl discusses the experimental results that have been submitted by Applicants in Declarations filed on November 2, 1998.<sup>2</sup> The results in these previous Declarations concerned vulcanized rubber products that were made using silicas prepared according to Applicants’ procedures and silicas prepared according to the procedures described in the references cited by the Examiner. Dr. Görl indicates that since the other components used in producing the compared vulcanized rubber products were essentially the same, the differences reported in experimental results can reasonably be attributed to the different silicas that were used. Thus, contrary to the Examiner’s assertions, one of skill in the art would attribute differences in the silicas used in compositions as being the contributing cause for the superior properties reported in Applicants’ Declarations. The Declarations are relevant to patentability and cannot be disregarded by the Examiner.

**B. Allegations of Inherency are Unfounded**

In paragraphs 8 and 9 of the present Declaration, Dr. Görl repeats the conclusions reached in Applicants’ previously submitted Declarations that the silicas of the present invention produce products with superior properties. He also indicates that the Examiner’s

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<sup>1</sup> A disclosure that is not enabling cannot be anticipatory.

<sup>2</sup> Dr. Görl was, himself, the Declarant on the previously filed Declarations. Thus, there should be no question regarding his familiarity with the Declarations or with the experiments described therein.

argument that, given the BET, CTAB and BET/CTAB values disclosed in Lagarde, all of the other properties recited for the silicas of Applicants' claims are fixed, *i.e.*, inherent, is factually incorrect. This being the case, Lagarde cannot be used to reject claims on novelty grounds. Also, in the absence of any explanation as to why the remaining claim characteristics would be obvious, a rejection under § 103 cannot reasonably be maintained. If the Examiner chooses to maintain the present rejection, Applicants respectfully request that the Examiner explain the basis for his allegation of inherency.

**C. Johnson Does Not Disclose a Process Essentially the Same as Applicants**

In rejecting claims based upon the Johnson reference, the Examiner has argued that the process of producing silicas disclosed therein is essentially the same as the process used by Applicants. Again, this is factually incorrect and Dr. Görl points out three specific significant differences in the processes in paragraph 10 of the present Declaration. Specifically, the precipitations in the Johnson reference used for preparing silicas are: a) performed at a significantly different pH than Applicants procedure; b) use a multistage, rather than one stage, method; and c) are carried out at a significantly lower solid concentration. Thus, the Examiner's allegation that the silicas disclosed in the reference must be the same as those claimed by Applicants is entirely unjustified.

**D. Lagarde Does Not Enable All Particles Less Than 45 Microns**

The Examiner has alleged, in essence, that the Lagarde reference encompasses all silica particles having a diameter of less than 45 microns. Thus, the reference allegedly anticipates Applicants' present claims which, as discussed by the Examiner on page 2 of the present Office Action, cannot have a size greater than 1.5 microns. As stated by Dr. Görl in paragraph 11 of the present Declaration, the Lagarde reference does not teach any method for producing silica particles with the size required by the present claims. The reference is not enabling and therefore can neither be anticipatory nor render claims obvious. If the Examiner chooses to maintain this rejection despite the enclosed Declaration, Applicants respectfully request that the Examiner specifically point out the teachings in Lagarde that would enable the production of particles of the required size.

**E. Summary**

Unless a patent examiner can set forth a basis for doubting the objective truth of the assertions made in a Declaration by an expert in a field, the assertions must be accepted. Therefore, an Examiner is not free to simply substitute unsupported allegations for the factually based conclusions set forth by an expert. In fact, unsupported allegations should not be used in rejecting claims at all. Applicants therefore respectfully submit that the present rejections have been overcome by the arguments made in the enclosed Declaration. It is therefore respectfully requested that these rejections be withdrawn.

**Conclusion**

In light of the amendments and discussion above, Applicants submit that all of the Examiner's rejections have been overcome. It is therefore respectfully requested that these rejections be withdrawn and that all of the claims presently pending in the application be allowed.

If, in the opinion of the Examiner, a phone call may help to expedite the prosecution of this application, the Examiner is invited to call Applicants' undersigned attorney at (703) 905-2039.

Respectfully submitted,

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